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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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| 08/269,936 | 07/01/94 | LINDEN | R 3570343 |

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KARL A VICK
WILLIAM BRINKS HOFER GILSON AND LIONE
PO BOX 10395
CHICAGO IL 60610

MCDERMID EXAMINER

ART UNIT

PAPER NUMBER

3306

DATE MAILED:

01/03/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Advisory ActionApplication No.
08/269,936

Applicant(s)

Linden et al.Examiner
Corrine M. McDermottGroup Art Unit
3306**THE PERIOD FOR RESPONSE:** [check only a) or b)]

- a) ☒ expires four months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Nov 27, 1995 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

- ☒ Applicant's response has overcome the following rejection(s):
The rejections under 35 USC 112 2nd paragraph, 102(b) and 103 have been overcome by the response.

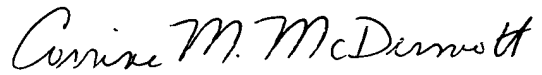
- ☒ Newly proposed or amended claims 32-34 and 36-60 would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: _____
- Claims objected to: 35 and 36
- Claims rejected: 1-9, 13-34, and 37-60
- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Other See attached paper.

Corrine M. McDermott
CORRINE M. MCDERMOTT
PRIMARY EXAMINER
ART UNIT 3306

Art Unit: 3306

Applicant's response has not overcome the rejection under 35 USC 112 first paragraph. In response to the rejection, applicant has argued that the drawings illustrate the claimed "restraint" in that the inner wall of catheter 21 holds the puncturing element in a retracted position. The fact that it holds the puncturing element in a retracted position does not also mean that it acts as a "restraint" as claimed. Further, applicant has show no support in the specification for the claimed "restraint". Upon a closer look at the specification, this examiner can not find any use at all of the word "restraint". If the wall of the catheter does, in fact, act as a restraint, the terminology must be made consistent between the claims and the specification.

With particular reference to newly amended claim 7, it is to be noted that claim 7 calls for a "restraint coupled to said catheter" which allows for the movement of the puncturing element from the retracted position to the puncturing position upon its *release*. Such language, which is found to describe the restraint as a structural piece of the invention independent of the catheter, is not supported in the specification or drawings. Clearly, the wall of the specification, if it is in fact the restraint, can not be "released" as claimed.


Corrine M. McDermott
Primary Examiner
Group 3300

CMM
December 26, 1995